

ESTTA Tracking number: **ESTTA96388**Filing date: **08/25/2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Akademi Sempoa & Mental Aritmetik U C MAS Sdn. Bhd.
Granted to Date of previous extension	08/27/2006
Address	568-8-44, Kompleks Mutiara, 3 1/2 MilesJalan Ipoh Kuala Lumpur, 51200 MALAYSIA

Domestic Representative	Paula Jill Krasny Partner Baker & McKenzie LLP 130 E. Randolph Drive Suite 3500 Chicago, IL 60601 UNITED STATES paula.j.krasny@bakernet.com Phone:312-861-2822
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Applicant Information

Application No	78633382	Publication date	02/28/2006
Opposition Filing Date	08/25/2006	Opposition Period Ends	08/27/2006
Applicant	Smart Brain America, Inc. 40 Hillside Avenue Williston Park, NY 11596 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2003/08/01 First Use In Commerce: 2003/08/01
All goods and sevicees in the class are opposed, namely: EDUCATIONAL SERVICES, NAMELY PROVIDING COURSE INSTRUCTION, GUIDANCE AND TOOLS FOR DEVELOPING THE RIGHT SIDE OF THE BRAIN USING THE ABACUS/SOROBAN

Related Proceedings	Opposition No. 91171679, serial no. 78/389287 opposed by Smart Brain America, Inc.
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Attachments	ucmas opposition.pdf (5 pages)(131739 bytes)
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Signature	/Paula Jill Krasny/
Name	Paula Jill Krasny
Date	08/25/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant:	Smart Brain America, Inc.)	
)	
Serial No.:	78/633382)	
)	
Filing Date:	May 19, 2005)	
)	
Mark:	SMART BRAIN AMERICA and design)	
)	
Published:	February 28, 2006)	
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)	Opposition No.
Akademi Sempoa & Mental Aritmetik U C MAS)	
Sdn. Bhd.)	
)	
	Opposer,)	
)	
	v.)	
)	
Smart Brain America, Inc.)	
)	
	Applicant.)	
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NOTICE OF OPPOSITION

Akademi Sempoa & Mental Aritmetik U C MAS Sdn. Bhd., a company organized and incorporated in Malaysia and having a business address at 568-8-44, Kompleks Mutiara, 3 ½ Miles, Jalan Ipoh, 51200 Kuala Lumpur, Malaysia (“Opposer”) believes it will be damaged by registration of Application No. 78/633,382 for SMART BRAIN AMERICA (and design) (“Applicant’s Mark”), and therefore opposes same. Smart Brain America, Inc. (“Applicant”) filed a trademark application for Applicant’s Mark on May 19, 2005, and the application was published for opposition in the *Official Gazette* on February 28, 2006. Opposer obtained extensions of time to oppose registration of Applicant’s Mark until and including August 27, 2006. As grounds for opposition, Opposer alleges that:

1. Opposer is a Malaysian company that offers through its franchisees educational services in nearly 30 countries throughout the world, including the U.S. Opposer's educational services focus on mental development.

2. On March 23, 2004, Opposer filed intent to use Application No. 78389287 for its highly distinctive house mark, which consists of a profile of a woman's head that contains lines differentiating the learning centers of the brain ("Opposer's Mark). Opposer's Mark is depicted below:



3. Over one year later, on May 19, 2005, Applicant filed an application to register Applicant's Mark, which is depicted below and also consists of the profile of a woman's head that contains lines differentiating the learning centers of the brain:



4. Because the design portions of Applicant's Mark and Opposer's Mark are virtually identical, the designs are the predominant feature of each mark, and each application covers educational services, there is a likelihood of confusion between Opposer's Mark and Applicant's Mark.

5. Given that Opposer's Mark and Applicant's Mark are virtually the same, each application covers educational services, and the application to register Opposer's Mark was filed over one year before the application to register Applicant's Mark, the US Patent and Trademark Office ("USPTO") should have refused registration of Applicant's Mark based on a likelihood of confusion.

6. Upon information and belief, at least one principal of Applicant used to work for or was otherwise affiliated with a former franchisee of Opposer in Thailand. Neither the former franchisee nor Opposer granted Applicant any rights to use or to apply to register Applicant's mark in the United States.

7. Because Applicant is not the owner of Applicant's mark under 15 U.S.C. § 1051(a)(1), Applicant's application is void *ab initio*.

8. Applicant, through its attorney, also stated in the Declaration to its application that Applicant:

- believes the applicant to be the owner of the trademark/service mark sought to be registered;
- to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive;
- and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

9. Upon information and belief, none of these statements was true at the time that Applicant instructed its attorney to sign the Declaration to Applicant's application to register

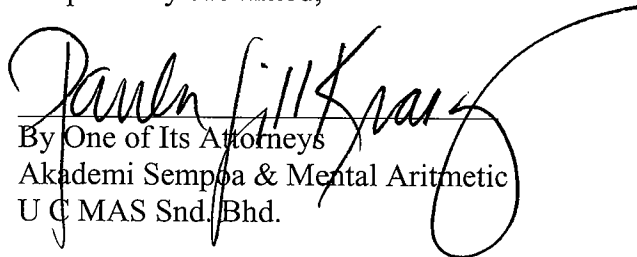
Applicant's Mark. By making such material false statements upon which the USPTO relied, Applicant has committed fraud on the USPTO and therefore is not entitled to registration.

10. Because Applicant is not the owner of the mark and has committed fraud on the USPTO, Applicant's Mark is not entitled to registration.

WHEREFORE, Opposer prays that the Application Serial No. 78/63382 be rejected, that no registration be issued thereunder to Applicant, and that this opposition be sustained in Opposer's favor.

Please charge the statutory filing fee of \$300.00, as well as any shortfall, missing or excess fee to Deposit Account No. 501-649, in the name of undersigned Attorneys for Opposer.

Respectfully submitted,


By One of Its Attorneys
Akademi Sempoa & Mental Aritmetic
U C MAS Snd. Bhd.

Date: August 25, 2006

BAKER & McKENZIE LLP
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John C. Filosa
Rebecca B. Lederhouse
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CERTIFICATE OF FILING

I hereby declare that the attached Notice of Opposition has been filed via the Electronic System for Trademark Trials and Appeals (ESTTA) this 25th day of August, 2006.


Paula Jill Krasny

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